

REMARKS

The last Office Action has been carefully considered.

It is noted that claim 1 is rejected under 35 U.S.C. 103 over the patent to Hoshino.

Claims 1-10 are rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims under 35 U.S.C. 112, claim 1 has been amended substantially as suggested by the Examiner. It is believed that the formal rejection of the claims should be considered as no longer tenable and should be withdrawn. The Examiner's suggestion is gratefully appreciated.

In accordance with the present invention, a method of making an conclusion about a presence or absence of photoresist in openings of photoresist masks is suggests. The method includes the steps of obtaining in a scanning electron microscope a video signal of a bottom of an opening of a photoresist mask and thereafter comparing values of the video signals in different points of an image which contains the opening.

Turning now to the references and in particular to the patent to Hoshino applied by the Examiner against the claims. It is respectfully submitted that the Examiner is correct in analyzing the method disclosed in the reference as well as a conclusion which can be made by a person skilled in the art. However, the present invention is different. In accordance with the present invention, values of the video signal in different points of an image which contains the opening are compared, which values are naturally digital values of the video signal.

The Examiner is correct in stating that when multiple SEM pictures are taken the intended purpose can be a comparison, and a person taking the pictures can inspect specific areas of the picture. However, it is not disclosed in the reference and it is not known in any prior art to compare values of the video signal in different points of an image which contains the opening, and to make a conclusion about a presence or absence of photoresist in openings of a photoresist mask based on the comparison of the values of the video signal in different points of the image which contains the opening.

It is therefore believed that the new features of the present invention which are defined in claim 1 are not disclosed in the prior art and

can not be derived from it as a matter of obviousness.

Claim 1 was rejected over the reference under 35 U.S.C. 103(a) as being obvious. The reference does not contain any hint or suggestion for such features. In order to arrive at the applicant's invention from the teaching of the reference, the reference has to be fundamentally modified. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the reference does not contain any hint or suggestion for such modifications.

It is also respectfully submitted that when the method is

performed in accordance with the present invention, instead of a simple observation of SEM pictures, the conclusion about the presence or absence of photoresist is made, which is much more accurate and reliable. The inventive method therefore provides highly advantageous results, that can not be accomplished by the solutions proposed in the prior art.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1, the broadest claim on file, should also be considered as patentably distinguishing over the art and should be allowed.

The Examiner's indication that claims 2-10 were not rejected has been gratefully acknowledged. In connection with this indication, claim

2 has been amended to make it independent. It is believed that the thusly amended claim 2 is now in allowable condition.

As for the dependent claims, these claims depend on claim 2, they share its presumably allowable features and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

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Extension Request

Pls extend the term for
response by 1 month.

The fee is enclosed.

If it is missing or
insufficient please

charge to 26-0085